

MAR 09 2010

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, both the undersigned and John Pokotylo would like to thank Primary Examiner Al Hashemi for courtesies extended during a telephone interview on February 17, 2010 (referred to as "the telephone interview"). The telephone interview is summarized here.

Telephone Interview Summary

This statement of the substance of the Interview summarizes the issues discussed during the February 17, 2010 telephone interview. This Interview Summary is presented in the format suggested in MPEP § 713.04 by the Patent Office.

Date of Interview: February 17, 2010

Type of Interview: Telephone

Name of Participants:

- Examiner: Sana Al Hashemi
- For Applicants: John C. Pokotylo
Len Linardakis

- A. **Exhibit(s) Shown:** None
- B. **Claims discussed:** 1
- C. **References Discussed:** U.S. Patent No. 5,948,061
("the Merriman patent")

D. Proposed Amendments discussed:

- Proposed amendments to the claims were discussed to overcome the rejection under 35 U.S.C. § 102. Specifically, the Examiner noted that claim 1 should be amended to clarify that the document relevance information is extracted from the document *by the client device*.

E. Discussion of General Thrust of the Principal Arguments

- The applicants' representatives discussed the claimed invention and their understanding of the teachings of the Merriman patent. Specifically, the applicants' representatives discussed how the ad request in the claimed invention includes information about the document, wherein the information is document relevance information including at least one concept of the content of the document, and wherein the document relevance information is automatically extracted (by a client side application) from the document requested.

- The applicants' representatives and Examiner Al Hashemi discussed possible ways claim 1 could be amended to clarify that the document relevance information is extracted from the document **by the client device**.

F. Other Pertinent Matters Discussed: None

G. General Results/Outcome of Interview

- The applicants' representatives agreed to amend claim 1, as requested by Examiner Al Hashemi, to clarify that the document relevance information is extracted from the document **by the client device**.

- Examiner Al Hashemi agreed that claim 13 clearly recites that the concepts from the content of a requested document are automatically extracted by the client device and does not need to be amended.

- Examiner Al Hashemi appreciated the distinctions between the claimed invention and the Merriman patent provided by the applicants' representatives.

Rejections under 35 U.S.C. § 102

Claims 1-3, 13, 18, 19, 29-32, 35-38, 42, 43, 44, 54, 59, 60, 70-73 and 76-79, are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,948,061 ("the Merriman patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 1 and 42, as amended, are not anticipated by the Merriman patent because the Merriman patent does not teach the combination of: (a) accepting, by the ad server system, document relevance information including at least one concept extracted, by the client device, from content of a document requested by the client device, **wherein the information concerning a document requested is generated and sent to the ad server system by at least one of (A) a browser application on the client device, (B) a browser plug-in on the client device, and (C) a browser toolbar on the client device, wherein the document relevance information is automatically extracted, by the client device, from the document requested;** (b) determining, by the ad server system, at least one ad relevant to content of the document using at least the accepted information to find matching serving constraints stored in association with ads; and (c) sending, by the ad server system, the at least one ad determined to the client.

Exemplary embodiments consistent with the claimed invention advantageously determine and serve ads **relevant to the content of the documents** requested by the end user. This document relevance information is **automatically extracted by the client device** from the requested document. Exemplary embodiments consistent with the claimed invention do not **require** the use of specific user information to determine relevant ads (although such information may be used). Specifically, the claimed invention is directed to a content-relevant ad server for serving content-relevant ads and a client device (such as an end user system for example) which may include one or more applications for (1) requesting one

or more content-relevant ads, and (2) rendering content-relevant ad(s) with content of a requested document. The request for content-relevant ad(s) may include:

information about the requested document such as (i) content from the document, (ii) relevance information (e.g., concepts, topics, categories, classifications, etc.) of the content of the document, and/or (iii) a document identifier (e.g., a URL of a Web page). Returned content-relevant ads may be rendered in association with the content of the document in any number of ways....

(Page 15, line 32 through page 16, line 4 of the present application) That is, **ads relevant to the content of the document requested** by a user are determined.

For example, an application residing on a client device may submit an ad request to the ad system. The request includes **information about a document** (e.g., concepts of the document) **which were extracted from the document by the client device** (e.g., a Web page on a content rendering application such as a Browser, an e-mail on an e-mail application, etc.). Specifically, the ad request may include information about the document, wherein the information is **"document relevance information including at least one concept of the content of the document, and wherein the document relevance information is automatically extracted, by the client device, from the document requested."**

By contrast, the Merriman patent discusses the "targeting of advertisements ... **based upon profiling of**

users and networks. [Emphasis added.]" (ABSTRACT)
During the telephone interview, Examiner Al Hashemi appreciated the aforementioned distinctions between the claimed invention and the Merriman patent provided by the applicants' representatives. The applicants' representatives agreed to amend claim 1, as requested by Examiner Al Hashemi, to clarify that the document relevance information is extracted from the document **by the client device.**

Thus, in view of the foregoing amendments and remarks, independent claims 1, 13, 42 and 54 are not anticipated by the Merriman patent. Since claims 2 and 3 directly or indirectly depend from claim 1, since claims 18, 19, 29-32 and 35-38 directly or indirectly depend from claim 13, since claims 43 and 44 directly or indirectly depend from claim 42, and since claims 59, 60, 70-73 and 76-79 directly or indirectly depend from claim 54 they are similarly not anticipated by the Merriman patent.

Rejections under 35 U.S.C. § 103

Claims 20-22 and 61-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Merriman patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Since claims 20-22 indirectly depend from claim 13, and since claims 61-63 indirectly depend from claim 54, the Examiner's assertions regarding the location of the second window do not compensate for the deficiencies of the Merriman patent with respect to claims 13 and 54

(discussed above), regardless of the presence or absence of an obvious reason to modify the Merriman patent. Therefore, these claims are not rendered obvious by the Merriman patent for at least the reasons discussed with respect to claims 13 and 54 above.

Claims 33, 34, 39-41, 74, 75 and 80-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Merriman patent in view of U.S. Patent No. 6,892,354 ("the Servan-Schreiber patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner cites column 3, lines 56-67 of the Servan-Schreiber patent as teaching submitting an ad request before a request for a document. The Examiner concluded that it would have been obvious to submit a request for ads before the document request in the Merriman patent because doing so would keep the user interested in the document or Website while the Website is downloading. (See Paper No. 20091030, page 6.)

Dependent claims 33, 34 and 39-41 directly or indirectly depend from claim 13, and claims 74, 75 and 80-82 directly or indirectly depend from claim 54. The purported teachings of the Servan-Schreiber patent do not compensate for the deficiencies of the Merriman patent with respect to claims 13 and 54 (discussed above), regardless of the presence or absence of an obvious reason to modify the Merriman patent in view of the purported teachings of the Servan-Schreiber patent. Therefore, these claims are not rendered obvious by the

Merriman and Servan-Schreiber patents for at least the reasons discussed with respect to claims 13 and 54 above.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

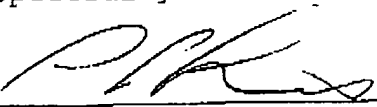
Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a

rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

March 9, 2010

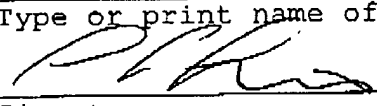

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March 9, 2010

Date